



Atty. Dkt. No. 071949-2406

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: BUECHLER et al.

Title: HYBRID PHTHALOZYANINE
DERIVATIVES AND THEIR USES

Appl. No.: 09/066,255

Filing Date: April 23, 1998

Examiner: M. Garcia

Art Unit: 1627

<p>CERTIFICATE OF MAILING</p> <p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231, on the date below.</p> <p><u>Jodie M. Rivas</u> (Printed Name)</p> <p><u>Jodie M. Rivas</u> (Signature)</p> <p><u>May 7, 2002</u> (Date of Deposit)</p>

TRANSMITTAL

Commissioner for Patents
Washington, D.C. 20231

Sir:

Transmitted herewith is:

- ☒ Response to Notification of Non-Compliance; and
- ☒ Appeal Brief (in triplicate).
- ☒ The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 50-0872 (Order No. 071949-2406). Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-0872 (Order No. 071949-2406).

Please direct all correspondence to the undersigned attorney or agent at the address indicated below.

Respectfully submitted,

Date May 7, 2002

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By Michael A. Whittaker

Michael A. Whittaker

Attorney for Applicant

Registration No. 46,230



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re the Application of:

Buechler, *et al.*

Serial No.: 09/066,255

Title: HYBRID PHTHALOCYANINE
DERIVATIVES AND THEIR USES

Filing Date: April 23, 1998

Group Art Unit: 1627

Examiner: Garcia, M.

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**RESPONSE TO NOTIFICATION OF NON-COMPLIANCE WITH THE
REQUIREMENTS OF 37 C.F.R. §1.192(C)**

Commissioner for Patents
Washington, D.C. 20231
Box Appeal Brief

Sir:

In response to the Notification of Non-Compliance with the Requirements of 37 C.F.R. §1.192(c), mailed on April 24, 2002 ("Paper No. 21"), please consider the following remarks and accompanying replacement Appeal Brief.

Appellants gratefully acknowledge the Examiner's efforts in indicating any lack of clarity that may have existed in Appellants' previously submitted Appeal Brief.

Appellants respectfully disagree with the Examiner's contention that Appellants' Appeal Brief, mailed on October 9, 2001, fails to contain an argument which specifies the errors in the two outstanding rejections based upon 35 U.S.C. §103.

In particular, while the Examiner contends that "Appellant does not list the separate rejections in the 'Issues' section... 'The Examiner's Rationale' section... or the 'Argument' section" of the Appeal Brief (Paper No. 21, page 3), Appellants respectfully note that no such requirement exists under 37 C.F.R. §1.192(c). Instead, the only requirement is that Appellants provide a "concise statement of the issues presented for review" and "the contentions of appellant with respect for each of the issues presented for review." See, 37 C.F.R. §§1.192(c)(6) and (c)(8).


Appellants also respectfully disagree with the Examiner's contention that "Appellant's 'Issues' section of the brief contains a considerable number of arguments." Paper No. 21, page 4. Appellants respectfully submit that the Examiner has confused factual statements concerning the various publications cited by the Examiner for argument.

Nevertheless, in an effort to clarify the issues and arguments presented in the Appeal Brief, Appellants have separately stated each contention of the Examiner. Moreover, because Appellants' arguments for the patentability of the claims are the same for each rejection under 35 U.S.C. §103, Appellants have stated an intent to address these rejections as a single Argument in the Appeal Brief. Appellants have also clarified the reasons why it is believed that the art relied on by the Examiner, taken as a whole, does not render Appellants' claims obvious.

Appellants respectfully request entry of the accompanying replacement Appeal Brief.

Respectfully submitted,
FOLEY & LARDNER

Dated: May 7, 2002

By: 
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